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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,356	10/21/2003	Fumitaka Ueda	Q77836	4209
7590 06/16/2005				
Sughrue Mion, PLLC 2100 Pennsylvania Avenue, N.W. Washington, DC 20037-3213				
		EXAMINER LETSCHER, GERALDINE		
		ART UNIT 1752		
		PAPER NUMBER		
		DATE MAILED: 06/16/2005		

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/689,356

Applicant(s)

UEDA ET AL.

Examiner

Geraldine V. Letscher

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al. (European Patent No. EP950922A1) in view of Kondo (U.S. Patent No. 6,080,535).

Ito et al. discloses a silver halide color photographic material having improved sharpness and color reproducibility, said material containing a coupler capable of releasing a photographically useful group or its precursor by a coupling reaction between the coupler and a developing agent in an oxidized form, wherein the coupler releases the photographically useful group or its precursor by an intramolecular nucleophilic substitution reaction using the nitrogen atom that directly bonds to a coupling position of a product obtained by the coupling reaction and that originates from the developing agent. The coupler of the general formula (I-3c) disclosed on page 6 is inclusive of the coupler of the instant formulae (I) and (II); also see exemplified coupler compound 27. Known silver halide emulsions are generally disclosed on pages 65-66, with no particular preference noted therein.

Kondo discloses a silver halide emulsion having enhanced sensitivity without increasing fog, said emulsion comprising tabular silver halide grains wherein at least 50% of the total grain projected area is accounted for by grains having an aspect ratio

greater than 5 and containing silver iodide, wherein the grains meet the relationship recited in the instant claims 5-8.

It would have been obvious to one of ordinary skill in the requisite art at the time the invention was made to incorporate the silver halide emulsion taught in Kondo into at least one silver halide emulsion layer of the photographic material of Ito et al., with reasonable expectations of achieving, absent object evidence to the contrary, the advantages taught therein as well as those achieved with the use of the emulsion.

Response to Arguments

3. Applicant's arguments filed March 21, 2005 have been fully considered but they are not persuasive.

Applicants' arguments are based upon the assertion that the couplers of the present invention are distinguished from those of the prior art of record, namely Ito et al. (EP'922), by the conditions of $(R_3)_m$ and/or INH, the mercaptoazole derivative. Applicants concede that exemplified coupler compound 27 of Ito et al. satisfies the aforementioned conditions with respect to $(R_3)_m$ and/or INH, but argue that compound 27 is "only incidentally included". Applicants have introduced newly added claim 17 and argue that at minimum, said compound is excluded from the limitations therein.

The Examiner maintains the position that the present claims are obvious over Ito et al. in view of Kondo. Ito et al. exemplifies a coupler entirely within the scope of the instant claims. Nonetheless, as disclosed in Ito et al., the exemplified coupler compounds do NOT limit the scope of usable couplers. The deficiency in Ito et al., i.e.,

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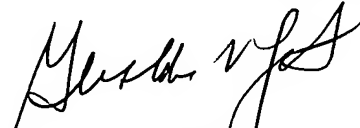
no specific preference of a particular silver halide emulsion, is compensated for by the teachings of Kondo.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geraldine V. Letscher whose telephone number is (571) 272-1334. The examiner can normally be reached 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (571) 272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


GERALDINE LETSCHER
PRIMARY EXAMINER
GROUP 1100

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).